

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of: Donna Hui-Ing HWANG et al.

Serial No.: 10/576,804

Group Art Unit: 1627

Filed: 21 April 2006

Examiner: Layla Soroush

For: CLIMAPROOF COSMETIC COMPLEX

**Pre-Appeal Brief**

**MAIL STOP: After Final**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

SIR:

The Examiner has erred in maintaining this rejection because the cited art does not teach or suggest all of the features of the claimed invention. For example, neither Chen nor Chung et al teaches elements (iii), (iv) and (v) of the present invention. When determining whether a claim is obvious, an examiner must make "a searching comparison of the claimed invention - including all its limitations - with the teaching of the prior art." *In re Ochiai*, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (emphasis added). "Obviousness requires a suggestion of all limitations in a claim." *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (citing *In re Royka*, 490 F.2d 981, 985 (CCPA 1974)).

The Chen reference fails to teach four out of the five recited elements in claim 1 and does not mention cosmetic compositions at all.

Claim 1: *A climaproof cosmetic complex, which comprises*

*(i) 0.1 to 90 % by weight of a gelled oil composition consisting of an oil component and a polymer component, which is a tri- block copolymer, a star polymer, a radial polymer, a multi-block polymer of polystyrene, polyethylene, polyvinyl chloride, polyisoprene, polybutadiene, an ethylene/butadiene copolymer, an ethylene/propylene copolymer, an ethylene/butylene copolymer, an ethylene-propylene/ diene copolymer, a styrene-ethylene/propylene copolymer, a styrene-ethylene/butadiene copolymer, a styrene-isoprene copolymer , a styrene-butadiene copolymer , a styrene-ethylene/propylene-styrene copolymer , a styrene-ethylene/butadiene-styrene copolymer, a styrene-isoprene-styrene copolymer , a styrene-butadiene-styrene copolymer , or a mixture thereof;*

- (ii) 0.1 to 80 % by weight of a water-repellent cross-linked polyester having a molecular weight of 600 to 8000 and consisting of polyvalent alcohol and dicarbonic acid monomers;*
- (iii) 0.01 to 20 % by weight of a water-absorbing powder having a particle size of 1 to 100  $\mu\text{m}$ , which powder is a natural plant powder rich in cellulose, maltodextrine, starch, a starch/polyacrylate copolymer, a synthetic polymer made from an acrylic monomer or mixtures thereof;*
- (iv) 0.01 to 20 % by weight of a thickening agent; and*
- (v) 0.1 to 50 % by weight of an organic solvent, a carrier substance, or a mixture thereof,*  
*wherein said cosmetic complex is water resistant and contains essentially no emulsifier.*

For example, Chen fails to teach the specific polyester and amount of water-repellent crosslinked polyester (ii), water-absorbing powders (iii), thickening agents (iv), and organic solvents (v). Nor does Chen teach amounts of any of the latter three elements in the climaproof cosmetic complex. Furthermore, the reference fails to teach the specific sizes of the water-absorbing powder (iii) or explain how these are obvious. On page 5 of the Final Office Action, the Examiner states: "The hydrophilic patches are held in place by the gel on one side and in direct contact with the skin" (col.6 lines 38-55), meeting limitation (iii) of claim 1 and 16 in part." This is incorrect. Element (iii) of claim 1 is a powder having a particle size of 1 to 100  $\mu\text{m}$ . Chen is silent regarding powders or particles sizes. Chen et al. discloses water-absorbing patches that are inserted through slits of a mask or other part of a gel composite body suite. See column 6 at lines 30-32. These patches are discrete pieces of cotton or other water absorbing material. They are not even part of Chen's fluffy gel composite. Furthermore, they are not part of a cosmetic complex that is water resistant.

On page 10 of the Final Office Action the Examiner contends that "the Chen reference teaches both components of the gel composition". This is incorrect. As previously noted, Chen is silent regarding component (ii) (i.e., 0.1 to 80 % by weight of a water-repellent cross-linked polyester having a molecular weight of 600 to 8000 and consisting of polyvalent alcohol and dicarbonic acid monomers).

Chung (KR2069596) is relied upon for teaching element (ii) (i.e., a cross-linked polyester consisting of a polyol and a dicarbonic acid). Chung is silent

regarding element (i) and like Chen et al., Chung is silent regarding water-absorbing powders (iii), thickening agents (iv), or organic solvents (v).

The Examiner also errs in disregarding the preamble. On page 2 of the Advisory Action, the Examiner contends that "Cosmetic complex" is intended use and does not receive patentable weight. The "wherein" clause of claim 1 (i.e., "wherein said cosmetic complex is water resistant and contains essentially no emulsifier") specifically refers to the preamble "cosmetic complex". Under *Catalina Mktg. Int'l* 289 F.3d 801, 808 (Fed. Cir. 2002) the preamble limits the claimed invention if it is "necessary to give life, meaning, and vitality to the claim." Thus, the preamble is limiting.

The Examiner also errs in combining selected elements from clearly non-analogous art. Chen et al (US 6,324,703) relates to a tear resistant insulating gel composition for extreme cold weather. The fluffy insulating gels can be molded into shapes and inserted into insulated clothing articles for the human body (e.g., boots, face masks, gloves, and full body wear), used as shock absorbers or acoustical isolators. They may also be used for making toys or balloons. See col. 2, lines 36-38, col. 29 lines 15-40, col. 31 lines 44-46 and col. 4 lines 1-3. Thus, Chen is clearly non-analogous art since it has nothing to do with a cosmetic complex that is water resistant. The Chen reference is also not reasonably pertinent to the present invention. A skilled worker trying to solve a problem in the field of cosmetic compositions for the skin would not logically look towards a teaching directed to insulating gels for use in protective clothing, shock absorbers or toys.

Chung (KR2069596) is also in an entirely different field (i.e., nonwoven fabric) from that of applicant's claimed invention (i.e., cosmetic complex that is water resistant) and is nonanalogous art. The reference is also not reasonably pertinent to the present invention and would not logically have commended itself to the inventor's attention. The function of the polyester of Chung et al. is to provide thermal adhesive properties to bind fibers together. A skilled worker in the art of cosmetic compositions would not consider incorporating a thermal adhesive (used to bind fibers) into a cosmetic composition for the skin without an explicit

teaching to do so. Thermal adhesion or fiber binding have not been shown to be factors considered in formulating cosmetic compositions which are water resistant.

The Examiner also errs in failing to articulate a reasonable rationale for combining the references. On page 8, first paragraph of the Final Office Action the Examiner alleges:

"the determination of optimal or workable proportions of the ingredients and size of the water-absorbing polymers by routine experimentation is obvious. One having ordinary skill in the art would have been motivated to do this to obtain the desired balance of better tensile, better tear better fatigue resistant and better feel gel properties." (emphasis added)

However, a skilled worker in the cosmetic art has not been shown to be concerned with the tensile strength or tear-resistance of a climaproof cosmetic complex. Hence, she would not look to the references for help in solving such a problem. Furthermore, the Chen reference does not provide a skilled worker with amounts of any components, much less the amounts of five components that work together to form a cosmetic complex that is water resistant and contains essentially no emulsifier. Furthermore, as noted on page 4, of the specification, "the gelled oil composition and the water-repellent cross-linked polyester are complementary in their properties...the overall effect of which exceeds the individual effect thus providing a synergistic effectiveness." Neither Chen et al. nor Chung et al. recognize this synergistic effect.

With respect to claim 11, the Examiner further relies upon Lennon to show an allegedly similar composition which is useful as a foundation. Lennon relates to a composition in the form of a water-in-oil emulsion, comprising an aqueous phase dispersed in an oily phase and containing at least one emulsifier. Nothing within Lennon would teach a skilled worker to remove the emulsifier. Other than mere allegation, the Examiner has not pointed to any similarities between the present invention and the compositions of Lennon. Thus, Lennon does not cure the deficiencies of Chen or Chung et al. This rejection is untenable at least for the reasons discussed above for the primary references.

The claimed invention as a whole, not just its individual elements or steps, must be considered. In the present invention, elements (i), (ii), (iii), (iv) and (v) are present in a single homogenous composition which forms a water resistant film on the skin. Neither Chen nor Chung would motivate one skilled in the art to solve a problem that is in no way disclosed or suggested in them. Since none of the references hint at waterproof cosmetic compositions and none of the references teach elements (iii), (iv) or (v), it is clear that appellants' own disclosure is impermissibly being used as a template to assert obviousness.

Thus, it is respectfully requested that the rejections under 35 USC §103 be withdrawn.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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